

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the indication that claims 21, 22, and 24 are allowed.

In the Official Action, the Examiner withdraws claims 2-4, 7-9, 12-14, 20 and 25-34 from further consideration as being drawn to a non-elected invention or species.

Accordingly, the withdrawn claims have been canceled except for claims 20 and 25 since such claims are directed to a non-elected species and dependent from allowable base claim 21.

Thus, Applicants respectfully request that claims 20 and 25 be allowed with claim 21. As discussed below, claims 20 and 25 have been amended to improve their form and readability and to conform to U.S. practice and style. Other claims have also been amended to improve their form and readability and to conform to U.S. practice and style.

In the Official Action, the Examiner rejects claims 1, 5, 6, 10, 11, 15, 18 and 23 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly

point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 6, 18 and 23, the Examiner argues that the specification does not provide support for the structure that makes up the claimed engaging means disposed in the introducing tube or the clip-tightening ring to prohibit the ring from being contained again in the introducing tube. The Examiner further rejects claims 6, 18, and 23 because the phrase "being contained again" is indefinite. The Examiner further rejects claim 1 because the base end of the clip and the wire are joined without an engaging means ... then an engaging means is recited. In response, claims 1 and 6 have been canceled and the claims have been amended to clarify such structure, which is fully supported in the disclosure.

Accordingly, it is respectfully requested that the rejection of claims 1, 5, 6, 10, 11, 15, 18 and 23 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner rejects claims 16, 17 and 19 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,766,189 to Matsuno (hereinafter "Matsuno").

In the Official Action, the Examiner argues that Matsuno discloses all of the features of claims 16, 17 and 19. Applicants respectfully disagree.

Applicants respectfully submit that the engaged state of the clip 2 and the hook portion 3A disclosed in Matsuno is different from the engaged state of the clip and manipulation wire as recited in claim 16 of the present application.

That is, in Matsuno, a recess 2e is formed in the side surface of the clip 2, and the hook portion is engaged with the recess from the one side of the clip (traverse direction normal to an advancing direction). On the other hand, as recited in claim 16, the tip end of the manipulating wire is inserted in the though hole which is extended in the advancing direction and formed in the base end of the clip, and the tip end (engaging portion) is engaged with the base end of the clip. In such a case, as the advancing direction is substantially the same as the longitudinally direction of the manipulating wire, the clip is not engaged with the side surface in the present invention. As a result, when the manipulating wire is moved in the retreating direction, a force for disengaging is efficiently applied between the engaging portion and the base end, and thus little force is needed for disengaging.

In a hooking-type engagement as described above as in Matsuno, a strong force is needed for disengaging. In a ligating apparatus, which must be structured to be as delicate as possible, it is highly advantageous to use a small force for disengaging.

With regard to the rejection of claims 16, 17 and 19 under 35 U.S.C. § 102(b), a ligating apparatus having the features discussed above and as recited in independent claim 16 is nowhere disclosed in Matsuno. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claim 16 is not anticipated by Matsuno. Accordingly, independent claim 16 patentably distinguishes over Matsuno and is allowable. Claims 17 and 19 being dependent upon claim 16, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 16, 17 and 19 under 35 U.S.C. § 102(b).


Furthermore, new claims 35-37 have been added to further define the patentable invention. New claims 35-37 are fully supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the addition of new claims 35-37. Applicants respectfully submit that new claims 35-37 are at least allowable as depending upon an allowable base claim (21).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

conference with Applicant's attorneys would be advantageous to the disposition of this case,
the Examiner is requested to telephone the undersigned.

Respectfully submitted,


Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:cm